

Amendment and Response under 37 C.F.R. 1.116

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Filed: May 25, 2001

Docket No.: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

REMARKS

The following remarks are made in response to the Final Office Action mailed Dec. 23, 2004, in which claims 1-29 were rejected. With this Response, amendments to the claims are presented to place the rejected claims in better form for consideration on appeal. No new matter has been presented. Claims 8, 9, 25, and 26- 29 have been canceled. New claims 30-32 have been added, and comprise canceled claims rewritten in independent form, as discussed below. Claims 1-7, 10-24 and 30-32 are pending in the application.

Claim Rejections under 35 U.S.C. § 103

Claims 1-29 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of Official Notice (with supporting evidence from "AOL, Wal-Mart to team on Net service"). Claims 10-12 and 25-26 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of Official Notice.

Applicants respectfully disagree with these final rejections. Accordingly, amendments to the claims are presented herein solely to place the rejected claims in better form for consideration on appeal. No new matter has been presented.

New claim 30 is previously presented dependent claim 28 rewritten in independent form, reciting wherein the Internet service provider offers a news channel featuring news stories of interest to a demographic group of members, and wherein the method further comprising providing to members a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article.

New claim 31 is original dependent claim 9, rewritten in independent form, reciting wherein providing members incentives comprises providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer through the co-branded Internet site.

New claim 32 is previously presented dependent claim 27, rewritten in independent form, reciting wherein providing members incentives comprises providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over

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which the merchandise discount is available varies on the basis of the length of a member's subscription to the Internet service provider.


CONCLUSION

In view of the above, Applicant respectfully request admission of this Amendment and Response under 37 C.F.R. 1.116, as the claims are placed in better form for consideration on appeal.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

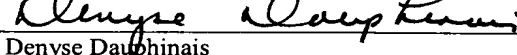
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Respectfully submitted,



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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7th day of March, 2005.

By 
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